

REMARKS/ARGUMENTS

In response to the Official Office Action of June 15, 2006, Applicants reply as follows:

Pursuant to a Restriction Requirement, claims 1-5 and 9-19 are pending.

Claims 2-4, 9 and 10 have been rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement allegedly upon the basis that the specification does not contain support for a combination of polymers (claims 2, 3, and 9) or a combination of fumed silica and calcium carbonate (claims 4 and 10). Applicants respectfully disagree. Page 9, lines 13-20 state that numerous thermoplastic polymers may be used and specific polymers are listed. It is readily understood to one skilled in the art that if a list of polymers is set forth, more than one polymer thereof or a blend thereof can be utilized. Thus, it is respectfully submitted that a basis is set forth for the term "or combinations thereof" in claims 2, 3 and 9. Similarly, with regard to the biodegradable polymer films, page 9, lines 21-30 state that preferred biodegradable polymer films include a list of several polymers and once again it is respectfully submitted that one skilled in the art would realize that not only can one polymer be utilized, but that blends or combinations thereof can also be utilized. Thus, page 11, lines 14-23 set forth the fact that a concentrate containing one of the noted polymers is diluted with another polymer, namely Equistar 940-094 LDPE and subsequently melt forming the mixture. On page 11, lines 24-28 another blend is formed containing Microthene FE 532 which is diluted with a polymer in which the tarnishing inhibitor ingredient will be essentially homogenously dispersed.

With respect to the combination of fumed silica and calcium carbonate, at least page 7, lines 3-6 state that the adjuvant "may be chosen from one or more of the following: dispersants such as fumed silica and calcium carbonate ...".

Hence, it is respectfully submitted that basis of support does exist for the term "or combinations thereof" in the noted claims and the 35 U.S.C. § 112 rejection is not proper.

Claims 1-5 and 9-19 have been rejected under 35 U.S.C. 103(a) as being unpatentable over reference WO 03/062346 A1. This reference is Applicants' related application that has been assigned to Northern Technologies International Corporation, Beachwood, Ohio. The reference claims a priority date of January 22, 2002 based upon U.S.

Serial No. 10/054,031. The named inventors are Donald Kubik, Boris Varshal, Efim Lyublinski, and Barbara Nygaard.

The present application is also assigned to Northern Technologies International Corporation of Beachwood, Ohio, see the enclosed Assignment, Exhibit A, and contains the exact same four inventors, Donald Kubik, Boris Varshal, Efim Lyublinski and Barbara Nygaard, as the WO 03/062346 reference. As set forth in the Filing Receipt, copy enclosed, Exhibit B, the present application is a CIP of U.S. Application 10/453,303, filed June 3, 2003 which in turn is a continuation of U.S. Serial No. 10/054,032 which was filed on January 22, 2002. This filing date is the exact same filing date as of the WO '346 reference. 35 U.S.C. §120 gives an Applicant benefit of an earlier filed U.S. application provided that at least one of the inventors is common to the one or more earlier filed patent applications and that there is co-pendency of the earlier applications. As set forth in the filing receipt of the continuation application, Exhibit C, and the Filing Receipt, Exhibit D, of the parent application bearing Serial No. 10/054,032 filed January 22, 2002, all four inventors are identical.

Moreover, the continuation application was filed on June 3, 2003 while the parent application was expressly abandoned upon the filing of the continuation application, that is, June 3, 2003, see Exhibit E. The present application was filed October 1, 2003 and was co-pending with the continuation application bearing Serial No. 10/453,303 inasmuch as a Notice of Abandonment was not mailed until December 6, 2004, Exhibit F. Since the WO '346 reference was not filed **before** the priority date of the present application, but on the same day thereof, it is not a valid reference under 35 U.S.C. 103 or any of paragraphs a) through g) of 35 U.S.C. 102 since all such sections relate to prior art publications and the like.

Support for the claimed subject matter of claim 1 and the claims dependent therefrom is respectfully deemed to be set forth in the parent application bearing Serial No. 10/054,032 filed January 22, 2002. For example, the polymers as well as the biodegradable polymers are set forth on page 4, paragraphs 1 and 2 of the parent application. These lists of polymers are identical to that set forth in the WO 03/062346 reference on page 7, lines 9-29 thereof. Applicants' claimed use of an alkali metal silicate such as sodium silicate is set forth on page 5, lines 13-20 of the parent application and the same is identical to the alkali metal

silicates set forth in the WO '346 reference on page 5, lines 14-20 thereof. With respect to Applicants' claimed use of zinc oxide, the same is set forth in Applicants' parent application on page 6 thereof, lines 6-19. As noted by the Examiner, zinc oxide is also utilized in the WO '346 reference as on page 6, line 11 thereof. Inasmuch as the same compounds such as the various polymers, alkali silicate compounds and zinc oxide are set forth in the WO 03/062346 reference as are set forth in the parent application (i.e. Serial No. 10/054,032) and since both were filed on the same day (i.e. January 22, 2002), the WO '346 publication is not a valid reference.

In summary, based upon the above facts and based upon 35 U.S.C. 120, it is respectfully submitted that the WO '346 publication is not a valid reference. Accordingly, it is deemed that Applicants have fully responded to the rejection of paragraph 5 of the Official Action of June 15, 2006 and hence need not argue the differences between the claimed invention and the teachings of the WO '346 reference.

Claims 1, 2, 5 and 16 have been rejected under 35 U.S.C. 103(a) as being unpatentable over EP 366305. It is alleged that this reference teaches stabilized low density polyethylene and can contain adjuvants such as those set forth on page 4 of the application such as UV stabilizers, anti-static agents, antioxidants, and the like. While this reference does teach zinc oxide in utilization with polyethylene, the thrust of this reference is the utilization of at least one transition metal catalyst of Group 4, 5, and 6 of the Periodic Table of the Elements such as titanium, vanadium, zirconium, and chromium.

Applicants invention relates to a tarnish inhibiting composition which comprises a non-hydrolyzable polymer including therein an alkali metal silicate and zinc oxide. The EP 366305 reference fails to teach any alkali metal silicate or any suggestion thereof. The alkali metal silicate is an important aspect of Applicants' invention inasmuch as it is an acid gas scavenger and thus protects metal objects from being tarnished by acid gases. Based upon this aspect alone, it is respectfully submitted that the EP 366305 reference fails to teach Applicants' invention.

It is further noted that the EP 366305 reference also fails to teach or suggest Applicants' biodegradable polymers as set forth in claim 2 and all dependent claims thereof.

In view of the above amendments and arguments, a formal notice of allowance of claims 1-5, 9-14, and 20-22 is earnestly solicited.

Respectfully submitted,

HUDAK, SHUNK & FARINE CO. LPA

A handwritten signature in black ink, appearing to read "Daniel J. Hudak". The signature is fluid and cursive, with the first name "Daniel" being more prominent than the last name "Hudak".

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